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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/12/2009

EXAMINER

OYEBISI, OJO O

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/046,834	Applicant(s) SINGHAL, TARA CHAND	
	Examiner OJO O. OYEBISI	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In the amendment filed on 05/26/2009, the following have occurred: claims 51, 54, 58-60, and 63 have been amended and claims 51-70 are currently pending. Applicant's remarks in the response filed 05/26/2009 has necessitated the withdrawal of the rejections of claims 51-70 under 35 U.S.C. 112, first paragraph

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 51-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (US PAT: 6,587,835) in view of Linehan (US PAT: 6,327,578).

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Re claims 51, 52-54. Treyz discloses a payment system between a customer and a merchant that facilitates privacy and security of customer private data including bankcard data from merchant systems during a payment transaction to the merchant, comprising:

- a. a merchant sales terminal with means wirelessly transmit a terminal identification and a payment amount for a specific sales transaction (see col.17 line 60-col.18 line 45, see fig.10 and fig.14).
- b. a wireless device of the customer with means to receive from the sales terminal, the terminal identification and the payment amount specific to the sales transaction (see col.17 line 60-col.18 line 45, see fig.10 and fig.14).
- c. the wireless device connects to a third party central system and transfers to the central system, a data record having a unique wireless device identifier, the terminal identifier and the payment amount (see col.17 line 60-col.18 line 45, see fig.10 and fig.14). Treyz does not explicitly disclose (d). the central system using pre-stored customer bankcard data and merchant identification data, assembles and submits a payment authorization request to an automated clearing house (ACH) network, thus bypassing the merchant sales terminal and the merchant system from receiving customer private data. However, Linehan discloses (d). the central system using pre-stored customer bankcard data and merchant identification data (i.e., issuer gateway, see col.4 line 24), assembles and submits a payment authorization request to an automated clearing house (ACH) network, thus bypassing the merchant sales terminal and the merchant system from receiving customer private data (see col.4 lines 10-65, see fig.3). Thus it would have been obvious to one of

ordinary skill in the art to combine the teachings of Treyz and Linehan to improve the overall performance in the payment process and to guarantee payment security.

Re claim 55. Treyz further discloses wherein the unique wireless device identification is a combination of a pre-programmed identification code and a customer entered card personal identification number (CPIN) (see col.18 lines 40-45).

Re claim 56. Treyz further discloses, the customer by entering the CPIN into the wireless device, identifies a specific account data to be used for a payment transaction, wherein the customer having a plurality of pre-stored account data in the central system, each identified by a CPIN (see fig.57, also see col.40 line 65-col.41 line 10, see col.17 line 60-col.18 line 15).

Re claim 57. Treyz further discloses, wherein, the central system maintains a transaction database cataloging each payment transaction by a transaction reference, date, time, an authorization reference, payment amount, customer identification and merchant identification (i.e., financial transaction records, see col.66 lines 8-36).

Re claims 63, 64-67. Treyz discloses a method that facilitates a private and secure payment transaction between a customer and a merchant without disclosing customer private data including bankcard data to the merchant during payment transactions, comprising the steps of:

a. transmitting by a merchant sales terminal, that has a means to wireless transmit, a sales

terminal identification and a payment amount incident to a sales transaction (see col.17 line 60-col.18 line 45, see fig.10 and fig.14).

. (b) receiving by a customer wireless device, that has an interface means to wirelessly receive, the merchant sales terminal identification and the payment amount specific to the sales

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transaction from the sales terminal (see col.17 line 60-col.18 line 45, see fig.10 and fig.14); c. connecting by the customer wireless device to a central system and transferring to the central system, a unique wireless device identifier, the sales terminal identification and the payment amount (see col.17 line 60-col.18 line 45, see fig.10 and fig.14). Treyz does not explicitly disclose d. assembling and processing a payment transaction, by the central system, with an automated clearing house network, using customer bankcard data and merchant identification data that is pre-stored in the central system. However, Linehan discloses d. assembling and processing a payment transaction, by the central system, with an automated clearing house network, using customer bankcard data and merchant identification data that is pre-stored in the central system (i.e., issuer gateway, see col.4 line 24, also see fig.3 and col.4 lines 10-65, see fig.3). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Treyz and Linehan to improve the overall performance in the payment process and to guarantee payment security.

Re claims 68, 69-70. Treyz discloses a payment system between a customer and a merchant that facilitates privacy and security of customer private data including bankcard data from merchant systems during a payment transaction to the merchant, comprising: a. a merchant sales terminal means for transmitting a terminal identification and a payment amount for a specific sales transaction and a customer wireless device means for receiving from the sales terminal (see col.17 line 60-col.18 line 45, see fig.10 and fig.14, the terminal identification and the payment amount specific to the sales transaction, and a wireless device connection means for securely transferring to a central system, a unique

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wireless device identifier, the terminal identifier and the payment amount (see col.17 line 60-col.18 line 45, see fig.10 and fig.14;). Treyz does not explicitly disclose b. the central system means for assembling and processing a payment transaction with an automated clearing house network using pre-stored customer bankcard data and merchant identification data, thus bypassing merchant sales terminals and merchant systems from receiving customer private data during the payment transaction. However, Linehan discloses b. the central system means for assembling and processing a payment transaction with an automated clearing house network using pre-stored customer bankcard data and merchant identification data, thus bypassing merchant sales terminals and merchant systems from receiving customer private data during the payment transaction (i.e., issuer gateway, see col.4 line 24, also see fig.3 and col.4 lines 10-65, see fig.3). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Treyz and Linehan to improve the overall performance in the payment process and to guarantee payment security.

5. **Claims 58, 59-62.** are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz in view Linehan, as applied to claim 51 supra, further in view of Foth (US PAT: 6,941,286).

Re claims 58, 59-62. Neither Treyz nor Linehan discloses, further comprising a merchant refund terminal on the global computer network, wherein the merchant enters into the refund terminal a refund record, including at-least the payment transaction reference from a previous payment transaction, the merchant identification, a refund authorizing password, a refund amount, and sending the refund record to the central system, the central system receives and verifies the

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elements of the refund record data with the transaction database, in particular verifies the refund amount is less than or equal to the payment amount, and creates a refund record including the merchant account identification, refund amount and submits to the ACH and receives an approval, and forwarding that to the refund terminal and the customer wireless device. However, Foth discloses further comprising a merchant refund terminal (i.e., post office) on the global computer network (see fig.1), wherein the merchant entering into the refund terminal a refund record, including at-least the payment transaction reference from a previous payment transaction, the merchant identification, a refund authorizing password, a refund amount, and sending the refund record to the central system, the central system receives and verifies the elements of the refund record data with the transaction database, in particular verifies the refund amount is less than or equal to the payment amount, and creates a refund record including the merchant account identification, refund amount and submits to the ACH and receives an approval, and forwards that to the refund terminal and the customer wireless device (see fig.3, also see col.4 line 22-col.5 line 50, also see the summary of the invention). Thus it would have been obvious to one of ordinary skill in the art to combine Treyz, Linehan and Foth in order to facilitate a refund for a disputed transaction between trading parties.

Response to Arguments

Applicant's arguments filed 11/06/2008 have been fully considered but they are not persuasive. The applicant argues in substance that Treyz fails to disclose a mobile wireless device/cell phone to receive in merchant terminal id and a payment amount for a specific sales

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transaction and for the merchant sales terminal to transmit such information, at the time of a payment transaction. The applicant's argument is predicated on the notion that Treyz cell phone transfers account information to the merchant sales terminal, but in claim 51, the account information is not loaded into the cell phone and the account information is not transferred to the sales terminal. Well contrary to the applicant's argument, the examiner fails to find a single limitation in claim 51 that states that the account information is not loaded into the cell phone and the account information is not transferred to the sales terminal. This statement might have been recited by the applicant in the specification, but not in the claim. The examiner contends that claims are interpreted in light of the specification, but the specification cannot be read into the claims. Claim 51 recites the limitation "a wireless device with means to receive from the sales terminal, the terminal id and a payment amount for a specific sales transaction." Contrary to the applicant's assertion, Treyz discloses that a handheld computing device 12 may be used for financial transactions. For example, the user may pay for a product in a store by wirelessly conveying information on the user's credit card, debit card, account, or other financial information to equipment in the store such as a cash register with wireless financial transaction capabilities. (53) Illustrative steps involved in using handheld computing device 12 in financial transactions are shown in FIG. 10. At step 160, handheld computing device 12 may be used to provide the user with an opportunity to provide financial information to handheld computing device 12 that is to be used in a financial transactions. For example, handheld computing device 12 may present on-screen options that allow the user to enter the digits for the user's credit card, debit card, or other account. Account information may relate to an account maintained by a store, mall, or other merchant or entity, or by a third-party service provider. Handheld computing

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device 12 may also allow the user to enter financial information by downloading the information from a personal computer or other device, by entering the information using dedicated keys, or by using any other suitable approach. If desired, the financial information may be stored at a remote location such as on a server associated with a service provider connected to communications network 32 of FIG. 2. Handheld computing device 12 may be provided with financial information and financial transaction capabilities using a smart card attachment or smart card circuitry that is integrated into handheld computing device 12 or using smart card protocols. (54) At step 162, the handheld computing device may be used to provide the user with an opportunity to use the financial information that was provided to handheld computing device 12 in a financial transaction. For example, handheld computing device 12 may display an on-screen option labeled "pay now" that the user can select when paying for a product or service, see col.17 lines 1-col.18 line 30, also see fig.10 and 14).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/

Examiner, Art Unit 3696